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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,911	09/18/2001	Arun B. Kulkarni	J&J-2049	8616
27777	7590	06/17/2004	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			LAMM, MARINA	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/954,911

Applicant(s)

KULKARNI ET AL.

Examiner

Marina Lamm

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,3-9 and 13-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/3/04 has been entered.
2. Claims pending are 1, 3-9 and 13-16. Claims 2 and 10-12 have been cancelled. Claim 1 has been amended.

Claim Objections

3. Claim 9 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 9 does not further limit the subject matter of Claim 3 because it recites viscosity stabilizers that are outside of the scope of the independent Claim 1, as amended.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3-6 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Han et al. (US 5,102,573).

Han et al. teach detergent compositions which may be in the form of gels and may be dispensed from pump sprayers. See col. 11, lines 25-31. A preferred composition of Han et al. contains 0.05% of xanthan gum, 1% glycerin, 1% of clay (colloidal magnesium aluminum silicate) and water. See col. 12, lines 6-16. The limitation "physically stable shear thinning" is inherent to the composition of Han et al. because it contains the same ingredients as recited in the instant claims. The recitation of intended use, i.e. "useful for delivering actives to skin", is not given any patentable weight. The courts have held that in composition claims "intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim." See *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963)

Thus, Han et al. teach each and every limitation of Claims 1, 3-6 and 9.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Yanagida et al. (US 5,484,816).

Yanagida et al. teach skin treatment compositions containing active agents such as vitamin A, clays such as hectolite and saponite, glycerol, propylene glycol, ethanol, water and 0.03% of citric acid. See col. 9, lines 9-47; col. 46, Example 14-11. The

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limitation "physically stable shear thinning sprayable gel" is inherent to the exemplified composition of Yanagida et al. because it contains the same ingredients as recited in the instant claims.

Thus, Yanagida et al. teach each and every limitation of Claim 1.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-9, 13, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagida et al.

Yanagida et al. applied as above. Example 14-11 of the reference exemplifies the composition containing 4% of clay (hectolite and saponite), while the instant claims recite "from about 0.4 percent to about 2 percent by weight" and "from about 0.7 percent to about 1.5 percent by weight". However, the reference teaches that the amount of clay may be as little as 0.01%, preferably 0.1%, and not exceeding 50% by weight, depending on the desired gelling effect. See col. 9, lines 38-47. It is the Examiner's opinion that the determination of optimal or workable amount of clay within the reference's generic disclosure by routine experimentation is obvious and within the skill of the art. One having ordinary skill in the art would have been motivated to do this to obtain the desired gelling properties of the composition.

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9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagida et al. in view of Kamishita (US 4,543,251), supplied by the Applicant.

Yanagida et al. applied as above. While teaching antioxidants and other skin care active agents, the reference does not teach menthol or camphor of the instant claims. However, Kamishita teaches using menthol in topical compositions to "impart a cool feeling to the skin." See col. 3, lines 40-45. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the topical composition of Yanagida et al. such that to add menthol. One having ordinary skill in the art would have been motivated to do this to obtain formulations that impart a cool feeling to the skin as suggested by Kamishita.

Response to Arguments

10. Applicant's arguments with respect to claims 1, 3-9 and 13-16 have been considered but are moot in view of the new ground(s) of rejection. See above.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5,871,764; SU 597715 (Abstract).
12. No claim is allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached at (571) 272-0602.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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6/9/04

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